

REMARKS

The amendment of claim 1 is supported, for example on page 4, lines 13-16 of the specification.

In section 1 of the Office Action, claim 2 has been objected to as reciting "the resin component a cross-linked polyester" which is stated to be grammatically incorrect. However, it is believed that the objection is not appropriate since the quoted phrase in claim 2 is part of a larger phrase, namely "contains as the resin component a cross-linked polyester", which is grammatically correct.

In section 2 of the Office Action, claims 3 and 4 and 7-12 have been objected to under 37 CFR 1.75 as being a substantial duplicate of "claims 3-4 and 7-12." as stated in the first sentence. This sentence appears to include a typographical error but it is assumed that it refers to the next two sentences identifying specific objections. Thus, the second sentence of section 2 states that "claims 3 and 4 appear to be the same as they are dependent upon claim 1 as claim 1 contains the binder".

It is noted, however, that claim 3 is dependent from claim 1 such that the crosslinked resin of the thermosoftening decorative print layer may be any of various resins, including a crosslinked polyester resin. In contrast, claim 4 is dependent from claim 2 which is limited to a crosslinked polyester as the resin in the thermosoftening decorative print layer such that claim 4 has the same limitation. Claim 4 is therefore narrower in scope than claim 3.

In the third sentence of section 2 of the Office Action, an objection is raised that the two claims in each of the pairs of claims 7 and 8; 9 and 10; and 11 and 12 are the same for the same reason as that stated in the previous sentence of the Office Action for concluding that claims 3 and 4 are the same. However, this conclusion is also not well grounded based on the same arguments as those expressed above to support the position that claims 3 and 4 are not the same.

Applicants agree that the position expressed in section 3 of the Office Action that two claims can be considered duplicates and thus not allowed in the same application despite a slight difference in wording. However, this is not the case in the pairs of claims objected to as duplicates in the Office Action since, as shown previously, there is a substantial difference in scope between the two claims of each pair.

In section 4 of the Office Action, claims 1 and 7-12 have been rejected as indefinite under 35 U.S.C. 112, second paragraph. The first problem expressed in the Office Action in connection with the rejection is that the binder layer is described in claim 1 as printed and thus normally contains a color, and the binder layer is recited in claims 7-12 as having transparency, the implication being that an article cannot be both colored and transparent. It is submitted, however, that this conclusion is not correct since many well known articles are both colored and transparent such as sunglasses and portions of automobile windshields.

The final sentence of section 4 of the Office Action objects to the phrase "by use of" in claim 1 as not indicating in which layer the low/non-crosslinking ink is located. It is believed that this objection has been overcome by the foregoing amendment of claim 1 to recite that the source of the binder layer is the low cross-linking or non cross-linking printing ink.

Section 6 of the Office Action rejects claims 1-12 under 35 U.S.C. 103(a) as being unpatentable over USPN 6,733,870 to Enlow et al. in view of JP 2001164163 to Ito.

Enlow et al. discloses a contoured multilayer protective and decorative surfacing film including as a composite an optically clear first layer bonded to a pigmented color coat, the entire film being supported on a molded rigid substrate, see Fig. 6 and col. 12, lines 13-36. As stated in the Office Action, Enlow discloses various polymeric binders for bonding the different layers, but does not include any crosslinking agent as part of such binders. Moreover, the Enlow disclosure does not mention the desirability of satisfying all the four indispensable requirements for a decorative film disclosed on page 2, lines 6-20 in the present application and satisfied by the article claimed in the application, nor is the film disclosed by Enlow described as inherently satisfying these requirements.

The failure of Enlow to disclose a multilayer film in which a colored layer, equivalent to the present inventor's thermosoftening decorative print layer, is bonded to a transparent top layer by a crosslinking binder, is not overcome by the disclosure of Ito of a printing ink containing a reflective flake pigment and a crosslinkable resin ink vehicle which fixes the position of the vehicle flakes with a high fastness to obtain the most desirable reflective result when the ink is applied to a surface. It should be noted that there is no indication in the disclosure of Enlow of any desirability of fixing the flakes of a reflective pigment in a single desired position, which is the only reason for the employment by Ito of a

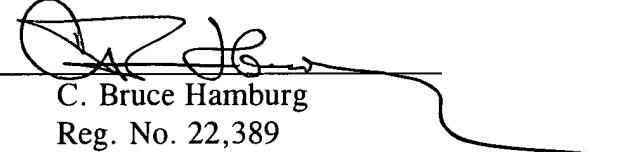
crosslinkable resin ink vehicle. Furthermore, there is nothing in the disclosure of Ito to indicate that the disclosed crosslinkable resin ink vehicle is suitable for making a decorative film which satisfies the four indispensable requirements of the present inventor's insert-molded article. In view of these factors, there is nothing which would lead a person having ordinary skill in the art to utilize a crosslinkable printing ink as a colored decorative print layer or coat which securely bonds a top transparent layer or coat to another layer coat on the other side of the print layer.

With regard to the remarks in section 6 on page 4 of the Office Action pointing out that the patentability of a product defined by a product-by-process claim depends on the structure of such product rather than the steps of the process, it is submitted that the patentability of the presently claimed product does in fact depend on its structure which is critically different from any product reasonably suggested by the combination of references, namely, the presence of a crosslinked decorative print layer on the backside of the top transparent film. This provides the improved adhesiveness to satisfy in a superior fashion the four indispensable requirements in the fabrication of an insert molded article of the type claimed in the instant application. Such crosslinked layer also results in an unexpected superiority in the structure of the produced article over articles produced by prior

art methods, as described in the discussion in the present application of the indispensable requirements satisfied by the claimed method.

The application is now thought to be in condition for allowance and such action at an early date is earnestly solicited.

Respectfully submitted,
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